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REMARKS

Claims 1-72, 74-216 and 218-290 are pending in the present application. Claims 1 and 145 are independent claims. By this reply, claims 73 and 217 have been cancelled and claims 289 and 290 have been added.

Interview Conducted

Applicants thank the Examiner for the personal interview conducted on November 17, 2004 with Applicants' representatives and for the Interview Summary. The above claim amendments were discussed during the interview and are made to clarify the invention.

35 U.S.C. 103 REJECTION

Claims 1-288 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent 6,213,652) in view of Goertz et al. (U.S. Patent 6,173,295), Guck (U.S. Patent 5,911,776) and Shimizu et al. (U.S. Patent 5,943,680). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Regarding independent claim 1, the Examiner states that Suzuki et al. teaches outputting and receiving a data stream in an independent format (PDL), but does not specifically teach translation of an input stream into a stream having a device independent format. Therefore, the Examiner relies on

Guck and alleges that Guck teaches this missing feature as recited in claim 1. Applicants respectfully disagree.

The Examiner correctly acknowledges that Guck discloses an automatic format conversion of a document into a format required by a requester of the document. However, the Examiner states that "since a source document can be converted to any device specific format, the document is device independent" (page 3, lines 3-4 of the final Office Action dated May 18, 2004). The Examiner also states in the Advisory Action that Guck as a whole suggests a "platform independent" data stream. These statements are erroneous and a complete misrepresentation of Guck and the claimed feature.

Claim 1 clearly requires, *inter alia* "a document generator at a client's side and configured to translate an input data steam into a data stream having an output device independent format and to output the device independent format data stream". Translating an input data stream of a certain format into a data stream of an *output device independent format* is different from converting a document of a certain format to *any one of many specific formats stored,* as taught by Guck. In Guck, a plurality of different types of converters directed to various formats that are used and required by different users must be present for a source document to be converted appropriately for a requester. In clear contrast, in Applicants' invention, at a client's side, an input data stream is converted to a data stream having an output device independent format. In such a case, there is no need to have a plurality of different

converters because the present invention converts the input data stream to a data stream having an output device independent format. Thus, in Applicants' invention, there is no need to know at a client's side the specific formats used and required by various users in the network. Guck's conversion is to a specific device format whereas Applicants' conversion is to a device independent format. Thus, Guck does not and cannot overcome this deficiency of Suzuki et al.

Furthermore, none of Suzuki et al., Guck, and Shimizu et al. discloses, *inter alia* "a computer configured to receive the device independent format data stream and programmed to analyze the data stream to determine a best output device" as recited in claim 1. The Examiner agrees and relies on Goertz et al. to correct this deficiency in the combination of Suzuki et al., Guck and Shimizu et al. However, Goertz et al. nowhere discloses the feature of analyzing the *output device independent format* data stream to determine a best output device.

Moreover, in Applicants' invention, once the best output device is determined, the computer further translates the output device independent data stream into a data stream specific for the determined best output device. This feature is completely absent from Suzuki et al., Guck, Shimizu et al., and Goertz et al., either taken singularly or in combination thereof.

Therefore, even if the references are combinable, assuming *arguendo,* the combination of references would still fail to teach or suggest at least the above-identified features of independent claim 1. The same arguments apply to

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traverse the rejection of independent claim 145 since claim 145 recites similar features as claim 1. In addition, none of the cited prior art teaches or suggests the feature of selectively outputting by the document generator at the clients' side a device specific format or the device independent format based on the selection signals, as set forth in claim 145.

In the alternative, Applicants wish to point out that none of the prior art of record teaches the features recited in dependent claims 4 and 148 depending respectively from claims 1 and 145. More specifically, claim 4 requires the features of determining a best output device based upon an affinity value for each output device. In Applicants' invention, values (affinity values) are assigned to the print jobs based upon the job size, destination and rendering characters. This affinity value is used to determine which device should receive the document. The affinity values for different devices are also calculated based on the devices' characteristics and attributes. See, e.g., page 2, line 34; page 12, line 15; page 13, line 19 – page 15, line 13 of the present application. Accordingly, by making the numerical calculations feasible and based upon the outcome of these calculations, making fine tuned decisions on how to deliver documents across the network is advantageously provided by Applicants' invention. This feature is neither taught nor suggested by any of the applied references.

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Accordingly, the invention as recited in independent claims 1 and 145 and their dependent claims is patentable over the applied references, and the rejection must be withdrawn.

CONCLUSION

For the foregoing reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

Should there be any matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Reg. No. 40,953) at the telephone number of the undersigned below.

Applicant(s) respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and 1.17 for a three-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of $980.00 is attached hereto.

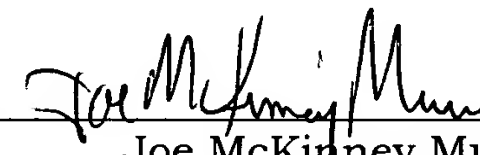If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit

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Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or

under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASH & BIRCH, LLP

By _____

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